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10/765,511	01/27/2004	Edward Snow Willis II	555255012694	2513

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EXAMINER	
KIMBALL, MAKAYLA T	

ART UNIT	PAPER NUMBER
2194	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/765,511	WILLIS, EDWARD SNOW	
	Examiner	Art Unit	
	Makayla Kimball	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 January 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02/23/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☒ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-11 are pending and are considered below.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because of the use of the legal phrase "said". Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: In figure 1, applicant fails to disclose "SIM/RUIM", number 144 in the specification was not explained.

Appropriate correction is required.

Claim Objections

5. Claims 4 and 7are objected to because of the following informalities: In claim 4 the word "previous" is misspelled and claim 7 is objected to as failing to provide proper antecedent basis for "NV".

Appropriate correction is required.

6. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Applicant has two number "10s". Misnumbered claims "10" been renumbered 10a (method) and 10b (wireless communication device). For examining purposes examiner will assume that claim 11 (wireless device) is dependent upon claim "10b" (wireless communication device).

Appropriate correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where at patent application claim to a genus is anticipated by a patent claim to a species

within that genus)." ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

8. "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is **"anticipated"** by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993))

9. Claims 1-8 and 10a-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/765512. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 of Application No. 10/765512 contains every element of claims 1-8 and 10a-11 of the instant application and thus anticipate the claims of the instant application. For example, looking at claim 1 in both applications, both claim checking to see if unique identifier exists and if it does exist to compare unique identifier with software identifier. Both also claim if unique identifier is different or does not exist to update and write software identifier to unique identifier, however, application 10/765511 claims updating though a network. Therefore, it would be obvious that the wireless device in application 10/7655112 would receive and transmit data to update through a network also. It is also obvious that the dependent claims of both applications are the same. Claims of the instant application

therefore are not patently distinct from the earlier patent claims and such are unpatentable over obvious-type double patenting. A later application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 7 and 10a are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 7: the word "NV management policies" was never defined for examination purposes the examiner will assume applicant meant the "rules" as specified on pages 9 and 10.

The "rules" mention "dynamic management" and "traditional management" which are also not defined. For examining purposes, examiner will interpret "traditional management" to mean having recent version and not updating.

Claim 10a: the word "traditional provisioning mechanisms" was not defined either, for examination purposes "traditional provisioning mechanisms" will be interpreted to mean "default".

12. Examiner's Note. The applicant appears to be attempting to invoke 35 U.S.C. 112 6th paragraph in claim 10b by using "means-plus-function" language. However, the examiner notes that the only "means" for performing these cited functions in the specification appears to be software. While the claim passes the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claims do not meet the other tests of the three-prong test. Therefore, 35 U.S.C. 112 6th paragraph has not been invoked when considering these claims below.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claims 1-11 are rejected under 35 U.S.C. 101. Claims 1, 10a and 10b are rejected under 101 because if-else statement is not complete. Applicant does not specify what would happen when the unique identifier and the software identifier are similar. Claims 2-9 and 11 are being rejected under 35 U.S.C. 101 as being dependent upon independent claims 1 and 10b.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1, 3-10b are rejected under 35 U.S.C. 102(e) as being anticipated by Birum et al (US PGPUB 2003/0221189).

Claim 1:

A method of dynamically managing non-volatile memory items in a wireless device through a network, said method comprising the steps of:

When connecting to said network [Figure 1], checking for a unique identifier item stored in said non-volatile memory items [0022, "where resources that belong to a particular version of an application are identified and placed in a list (hereinafter this version is called "V1")"];

If said unique identifier exists, checking whether a value stored in said unique identifier is the same as a software identifier [0006, "current version of an application is created and compared to the list of resources in a new version"; 0029, where the process compares the resource in V2 with the resource in V1."] located in software [0009, "for the new version stored locally on the client" (Since software identifier stored in software, therefore it is \ inherent that the new version must be stored locally.)] on said wireless device [Figure 1, "140"; 0051, "wireless links" (Wireless is creating a wireless link therefore, it is inherent you have a wireless device.)];

If said unique identifier item does not exist [0039, "When a resource exists in V2 that does not exist in V1"] or if said identifier is different from said software identifier [0030, "If the resources are different"], sending said software identifier along with an identifier [0046, "a client can change a file, such as a configuration file, and cause

that file to be sent back to a server." (Configuration file that consists of identifiers)] indicating a carrier [0054, "carrier wave"] to said network [Figure 1, "140"];

Receiving from said network [Figure 1; 0051, "receives transmitted messages"] a set of changes related to said software [0011, "resources needed for the new version that are not in the current version"];

Executing said set of changes [Figure 7, "715"] to update said non-volatile memory items [0043, "downloaded all or a subset of the resources required to change a version"]; and

Writing said software identifier to said unique identifier item [0045, "the process may maintain data contained in the old configuration file while modifying the configuration file to be compatible with the new version." (Modifying old configuration file to be compatible with new version allows easy tracking both old and new version)].

Claim 3:

The method of claim 1, wherein said writing step is performed after said updating step is complete [0009, "client downloads the resources...modifies a data structure..."; 0045, "while modifying the configuration file to be compatible with the new version."].

Claim 4:

The method of claim 1, wherein said updating step allows rollback to a previous software version [0006, "the version of an application may be updated or rolled back"].

Claim 5:

The method of claim 4, wherein said updating step preferably creates a new non-volatile memory item rather than replacing an existing non-volatile memory item to facilitate rollback to said existing non-volatile memory item. [0045, "should not be overwritten...the upgrade list may specify that it should not be replaced."].

Claim 6:

The method of claim 5, wherein said updating step does not delete non-volatile memory items that have previously been created [0041, "the client may or may not actually delete"; 0045, "upgrade list may specify that it should not be replaced."].

Claim 7:

The method of claim 6, wherein non-volatile memory items managed under other NV management policies are not updated in said updating step [0038, "If the client has the most recent version, it may begin executing an application associated with the content." (If the versions are the same then there is no need to update.)].

Claim 8:

The method of claim 5, wherein software on said wireless device includes a mapping from old non-volatile memory items to new non-volatile memory items [0045, "process may maintain data contained in the old configuration file while modifying the configuration file to be compatible with the new version." (Modifying configuration file to make it compatible requires mapping of the two versions.)].

Claim 9:

The method of claim 8, wherein said mapping is modified using said set of changes [0045, "process may maintain data contained in the old configuration file while modifying the configuration file to be compatible with the new version." (In order to modify old configuration file you need to have a set of changes to make it compatible with new version.)].

Claim 10a:

A method for dynamically managing non-volatile memory items on a wireless device during registration to a network, said method allowing rollback to previous versions of software using said non-volatile memory items, said method comprising the steps of:

On registration [0051, are "intermediary devices on a communications network...remotely connected"], checking the non-volatile memory items for a unique identifier [0022, "where resources that belong to a particular version of an application are identified and placed in a list (hereinafter this version is called "V1")"];

If said unique identifier item exists, checking whether a value in said unique identifier item is the same as a software identifier; [0006, "current version of an application is created and compared to the list of resources in a new version"; 0029, "where the process compares the resource in V2 with the resource in V1."]

If said unique identifier item does not exist [0039, "when a resource exists in V2 that does not exist in V1..."] or if said identifier is different from said software identifier [0030, "If the resources are different..."], performing steps of:

Sending said software identifier along with an identifier [0046, "a client can change a file, such as a configuration file, and cause that file to be sent back to a server." (Configuration file that consists of identifiers)] indicating a carrier [0054, "carrier wave"] to said network [Figure 1, "140"];

Receiving a set of changes from said network [Figure 1; 0051, "receives transmitted messages"] to update said non-volatile memory items, said updating step: [0011, "resources needed for the new version that are not in the current version"]

Creating a new non-volatile memory item rather than replacing an existing non-volatile memory item to facilitate rollback; [0045, "should not be overwritten...the upgrade list may specify that it should not be replaced."]

Retaining non-volatile memory items that have previously been created; and [0041, "the client may or may not actually delete"; 0045, "upgrade list may specify that it should not be replaced."]

Avoiding non-volatile memory items created by traditional provisioning mechanisms; and [0045, "When so designated, if such resources do not exist on a client computer, they may be updated with a "default"..." ("Traditional provisioning mechanisms" are considered well-known methods because "traditional" indicates old and well known.)]

Writing said software identifier to said unique identifier item [0045, "the process may maintain data contained in the old configuration file while modifying the configuration file to be compatible with the new version." (Modifying old configuration file to be compatible with new version allows easy tracking both old and new version)], whereby said creating, retaining, and avoiding steps in said updating step allows rollback to previous versions of software on said wireless device [0006, "the version of an application may be updated or rolled back"].

Claim 10b:

A wireless communication device comprising:

A receiver for receiving signals from a network; [0051, "receives transmitted messages"]

A transmitter for transmitting signals to a network; [0051, "receives transmitted messages and forwards them to their correct destinations over available routes."]

A digital signal processor for processing signals to be sent on said transmitter and received on said receiver; [Figure 3, "302"]

A microprocessor communicating with said digital signal processor; [Figure 3, "306"]

Non-volatile memory having program storage and non-volatile memory items [0061, "Computer storage media may include volatile and nonvolatile, removable..."], said non-volatile memory communicating with said microprocessor [0051, "many computers through a mesh of possible connections..."; 0061, "store the desired information and which can be accessed by a computing device."]; and

Input and output subsystems interacting with said microprocessor, wherein said microprocessor including: [Figure 3, "320"]

Means for checking said non-volatile memory items for a unique identifier item, [0022, "where resources that belong to a particular version of an application are identified and placed in a list (hereinafter this version is called "V1")"]

Means for checking whether a value stored in said unique identifier item is the same as a software identifier [0006, "current version of an application is created and compared to the list of resources in a new version"; 0029, "where the process compares the resource in V2 with the resource in V1."];

Means for updating said non-volatile memory; [0045, "downloaded all or a subset of the resources required to change a version"]

Wherein if said means for checking said non-volatile memory for a unique identifier item finds that said unique identifier item does not exist [0039, "When a resource exists in V2 that does not exist in V1"] or said means for checking whether said value finds said value is different from said software identifier [0030, "If the resources are different"],

Said wireless device sends said software identifier to said network and receives a set of changes, [0046, "a client can change a file, such as a configuration file, and cause that file to be sent back to a server." (Configuration file that consists of identifiers); 0051, "receives transmitted messages"] from said network [Figure 1] said means for updating said non-volatile memory executing said set of changes [0043, downloaded all or a subset of the resources required to change a version]

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

> Determining the scope and contents of the prior art.
> Ascertaining the differences between the prior art and the claims at issue.
> Resolving the level of ordinary skill in the pertinent art.
> Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birum et al (2003/0221189) in view of Moore et al (2002/0078142).

Claim 2 and 11:

Birum discloses the method as in claims 1 and 10b above, but does not disclose the unique identifier and software identifier as being version numbers. Moore does disclose a similar method as in claim 1 and 10b, and in addition the identifiers are version numbers [Figure 6A]. Birum and Moore are in the same field of endeavor so it would have been obvious to a person of ordinary skill in the art at the time the invention was made to create unique version number and compare version numbers in order to insure comparing not only the same software but also the same version of the software.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roush (US PGPUB 2004/0216133) discloses a method and a system for software upgrades with multiple versions.

Gentoo Linux Documentation – Portage manual discloses updating and having multiple versions.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Makayla Kimball whose telephone number is 571-270-1057. The examiner can normally be reached on Monday - Thursday 10AM - 3PM EST.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Myhre James can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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07/21/2006

James W. Myhre
Supervisory Patent Examiner